

REMARKS

Claims 1 - 24 remain active in this application and are subject to a requirement for restriction. No new matter has been introduced into the application.

The Examiner has required restriction between the invention of Group I, claims 1 - 14, asserted to be directed to a method for making a substrate and Group II, claims 15 - 24, asserted to be directed to a mask structure. A provisional election has been made, with traverse, of the invention of Group II. The requirement for restriction is respectfully traversed for the reasons set out below.

While the claims of Group I are directed to a method and the claims of elected Group II are directed to a mask structure, it is respectfully called to the Examiner's attention is called to the fact that the preamble of claim 1 recites a "method of protecting a material surface" which is achieved by recited steps which result in a particular type of mask which has properties that enhanced protection of the surface through developing an interface which is one of a (Markush) group consisting of a chemical reaction interface, a grain interface and a material interface. This Markush group is recited in both independent claims 1 (Group I) and 15 (Group II).

Therefore, it is respectfully submitted that the characterization of the invention of Group I as a method of *forming* a substrate is incorrect. Further, particularly in view of the Examiner's characterization of Group I, the example given of a materially different device that could be made by the method ("a substrate for a semiconductor integrated circuit device") is illusory and, in fact, far from being materially different from the invention of Group II, the method would result in the

same mask structure, as distinct from the semiconductor device manufactured using the mask. Moreover, since both inventions, as identified by the Examiner form (as in Group I) or exploit (Group II) the same kinds of structures/interfaces claimed by the same Markush group, the Examiner has not, in fact, demonstrated that the searches would be in any way divergent but seemingly would necessarily be largely congruent, regardless of asserted classification.

Accordingly, it is respectfully submitted that the above clear errors in characterization of the invention(s) prevent a *prima facie* demonstration of independence or distinctness of the inventions from being made which properly supports the requirement for Restriction. Additionally, no *prima facie* demonstration of the existence of a serious burden of examination in the absence of the requirement for restriction has been made. As the Examiner is aware, a *prima facie* demonstration of *both* the independence/distinctness of identified inventions and the existence of a serious burden of examination in the absence of such a requirement must be made in order to support a proper requirement for restriction. Further, it is respectfully submitted that the above errors confuse the line of distinction between the identified invention such that the protection against a rejection for double-patenting might be compromised.

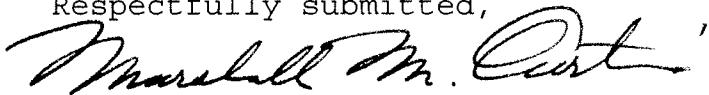
Therefore, it is respectfully submitted that the requirement for restriction is in error and improper and, upon reconsideration should be withdrawn. However, should the Examiner adhere to the Requirement for Restriction, it is respectfully requested that the requirement be restated in a proper manner accurately recognizing and characterizing the actual subject matter

of the identified Groups of claims corresponding to the respective identified inventions in order to clarify the record and avoid prejudice to Applicants.

Since all requirements contained in the outstanding official action have been fully answered and shown to be in error and/or inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 C.F.R. §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 09-0458 of International Business Machines Corporation (East Fishkill).

Respectfully submitted,



Marshall M. Curtis
Reg. No. 33,138

Whitham, Curtis, Christofferson & Cook, P. C.
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190

(703) 787-9400
Customer Number: 30743